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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/643,655

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Jim Irving Jones

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02/03/2009

PATENT DOCUMENTATION CENTER

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EXAMINER

PARKER, BRANDI P

ART UNIT

PAPER NUMBER

3624

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/643,655	Applicant(s) JONES, JIM IRVING	
	Examiner BRANDI P. PARKER	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. The following is a Final Office action in response to communications filed on 11/10/2008. Claim 1 has been amended.

Response to Applicant's Remarks

2. Whether a method appropriately includes particular machines to qualify as a section 101 process may not always be a straightforward inquiry. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *In re Comiskey*, 499 F.3d 1365, 1380 (Fed. Cir. 2007), (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). In other words, nominal or token recitations of structure in a method claim should not convert an otherwise ineligible claim into an eligible one. *Ex parte Langemyr* (BPAI 2008-1495, 2008).

3. Applicant's amendment to claim 1, has been fully considered and is not persuasive. Specifying that a method is "computer-implemented" does not tie the method to a particular machine in order to comply with 35 USC § 101. The rejection of claims 1-7 under 35 USC § 101 has been sustained.

4. Applicant's arguments with respect to claim 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Examiner's Notes

5. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crabtree et al (US 5937084) in view of Goldthorpe (US 2004/0249832).

8. With respect to claims 1, 4 and 6, Crabtree teaches a method for managing knowledge within an enterprise, comprising:

a. identifying a body of noise, data, information and knowledge for the enterprise comprising skills, theories, rules, processes, techniques, instructions for action used by the enterprise to solve problems and to produce output, some of which has been recorded in documents and some of which is unrecorded form (column/line 7/52-8/13, regarding noise filtered tokens in the knowledge database);

b. analyzing the body of noise, data, information and knowledge to identify a plurality of knowledge objects, wherein a knowledge object comprises specific knowledge contained within the body of knowledge which is used by an enterprise process to produce an output having value to the enterprise (column/line 7/52-8/13, regarding noise filtered tokens in the knowledge database).

Crabtree does not directly teach creating an optimized flow and defining taxonomies and classifications. However, Goldthorpe teaches:

- c. capturing any unrecorded knowledge objects and recording them in documents (paragraph 0071, regarding tacit knowledge);
- d. identifying a measurable business environment comprising a plurality of measurable enterprise processes, wherein the plurality of enterprise processes use the plurality of knowledge objects to produce the outputs having value to the enterprise and measuring the flow of each knowledge object through its associated measurable enterprise process to produce the associated output to determine a baseline flow for the knowledge object (paragraph 0063);
- e. modifying the enterprise process and measuring the flow of the knowledge object through the modified enterprise process until an optimized flow for the knowledge object has been achieved (paragraph 0072, 0081 – best practices and benchmarks create optimized flow);
- f. defining a knowledge taxonomy for the enterprise comprising a classification system for classifying the plurality of knowledge objects for the enterprise (paragraph 0051); and
- g. classifying the body of recorded knowledge objects according to the knowledge taxonomy for the enterprise (paragraph 0051-0059, 0064).

It would have been obvious to one of ordinary skill in the art to include the business system of Crabtree with the ability to creating an optimized flow and defining taxonomies and classifications as taught by Goldthorpe since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

9. Regarding claim 3, Goldthorpe teaches the method of claim 1, wherein defining a body of knowledge comprises:

- h. collecting data pertaining to skills, theories, rules, processes, techniques, instructions for action used by the enterprise to solve problems and to produce output (paragraph 0036);
- i. transforming the collected data into information comprising summaries and correlations of data (paragraph 0046); and
- j. validating the information using analytical, statistical and logical methods or by peer group review to produce knowledge (paragraph 0063, regarding the review stage of the knowledge content process cycle).

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10. As to claim 2, Goldthorpe teaches the method of claim 1, further comprising:

k. periodically re-defining the body of knowledge for the enterprise to include new skills, theories, rules, processes, techniques, instructions for action used by the enterprise to solve problems and to produce output, some of which has been recorded in documents and some of which is unrecorded form and to remove those skills, theories, rules, processes, techniques, instructions for action which are no longer used by the enterprise to solve problems and to produce output and periodically re-analyzing the body of knowledge to identify additional knowledge objects contained within the body of knowledge to be included in the plurality of knowledge objects (paragraph 0075; regarding learning cycle of the knowledge manager where new data is created, captured or stored).

Goldthorpe does not explicitly teach removing no longer needed knowledge objects from the plurality of knowledge objects. However, claim 2 would be a predictable result of the method and system disclosed in Goldthorpe because removing outdated or unnecessary data objects during the evolution of a business consist of a known method in industry to maintain efficiency in business analysis. *KSR v. Teleflex*, 82 USPQ2d, 1385 (2007). Therefore, it would have been obvious to one with ordinary skill in the art to remove unwanted knowledge objects from the plurality of knowledge objects.

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11. As to claim 5, Goldthorpe teaches a creating a knowledge taxonomy for a business enterprise relating to various aspects of management (paragraph 0051-0059, 0064). Goldthorpe does not explicitly teach wherein the knowledge taxonomy initially classifies documents according to competitive documents, transactional documents, capability documents and external documents. However, a predictable result of the method and system in Goldthorpe would be the implementation of the specific classification according to the needs of the organization. *KSR v. Teleflex*, 82 USPQ2d, 1385 (2007). Therefore, it would have been obvious to one with ordinary skill in the art to use the system in Goldthorpe to classify documents into the specific categories of competitive, transactional, capability and external documents.

12. With respect to claim 7, Goldthorpe teaches using business management strategies common management tools and techniques to determine best practices and benchmarks for the business enterprise paragraph 0081-0088). Goldthorpe does not explicitly teach the usage of a Six Sigma framework. It has been held that express suggestion to substitute one equivalent technique for another need not be present to render applications are obvious in view of the prior art if what is claimed is no more than simple substitution of one known element for another, or mere application of a known technique a piece of prior art. *Ex Parte Smith*, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007) Therefore, it would have been obvious to one with ordinary skill in the art to substitute one known business management strategy for another by substituting the Six

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Sigma framework for the business management strategies provided in Goldthorpe to reject claim 7.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDI P. PARKER whose telephone number is (571) 272-9796. The examiner can normally be reached on Mon-Thurs. 8-5pm.

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16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley B. Bayat can be reached on (571) 272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRANDI P PARKER/
Examiner, Art Unit 3624

/Bradley B Bayat/
Supervisory Patent Examiner, Art Unit 3624